

REMARKS

Claims 1-15 are pending in the application.

Claims 1-15 have been rejected.

Claims 16-20 have been added.

Reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1, 2, 12, 13 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brennan et al. (US 5,329,578). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Regarding independent Claims 1, 12 and 15, the Office Action asserts that Brennan's Special Callers List identically teaches the Applicant's element of "a log of past incoming communications." Moreover, the Office Action argues that Brennan discloses "that upon receipt of the incoming call, examining the Special Callers List and based on previous communications from the caller, assessing the urgency." See, Office Action, page 2.

First, Brennan's Callers List 26 "stores the identities of callers requiring special treatment, and the special treatment that is provided to them." (Brennan, col. 4, line 67, to col. 5, line 2). Second, the passages cited by the Office Action do not appear to recite that upon receipt of an incoming communication, the log (past incoming communications for the recipient) is examined and based upon previous communications from the originator (of the incoming communication), assesses the urgency. Therefore, the Office Action has failed to demonstrate anticipation of each and every element of the Applicant's independent Claims 1, 12 and 15 (and dependent Claims 2 and 13) arranged as they are in the claims.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1, 2, 12, 13 and 15.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan et al. (US 5,329,578) in view of Smith et al (US 6,141,412). Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan et al. (US 5,329,578) in view of Schweitzer (US Publ. 2002/0176545). Claims 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan et al. (US 5,329,578) in view of Schweitzer (US Publ. 2002/0176545) and further in view of Arledge et al (US 5,561,703). Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan et al. (US 5,329,578) in view of Schweitzer (US Publ. 2002/0176545) and further in view of Arledge et al (US 5,561,703) and further in view of Miller, Jr. (US 6,442,249).

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan et al. (US 5,329,578) in view of Arledge et al (US 5,561,703). The rejections are respectfully traversed.

Applicant believes that Schweitzer is unavailable as prior art against the present application because Schweitzer has a filing date after the filing date of the present application. While Schweitzer is a continuation-in-part of a previously filed parent application, the Office Action fails to establish that all the material and teachings cited from Schweitzer are described in the parent application. As a result, Schweitzer is unavailable as “prior art” against the present application, and the Office Action has failed to establish a *prima facie* case of obviousness with respect to Claims 5-11.

Additionally, Claims 3-11 depend from independent Claim 1 and incorporate the features/elements therein recited. Thus, for the same reasons given above in response to the §102 rejection of independent Claim 1, none of the cited references either alone, or in combination, disclose, teach or suggest all the features/elements of dependent Claims 3-11 and, therefore, a *prima facie* case of obviousness has not been established.

Further, Claim 14 depends from independent Claim 12 and incorporates the features/elements therein recited. Thus, for the same reasons given above with respect to the §102 rejection of independent Claim 12, none of the cited references either alone, or in combination, disclose, teach or suggest all the features/elements of dependent Claim 14 and, therefore, a *prima facie* case of obviousness has not been established.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 3-11 and 14.

III. NEW CLAIMS

New Claims 16-20 have been added. Claims 16-19 depend directly or indirectly from independent Claim 1, and Claim 20 depends from independent Claim 12. For the reasons given above with respect to independent Claims 1 and 12, the new claims are believed patentable over the art of record.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

ATTORNEY DOCKET No. 13016STUS01U (NORT10-00101)
U.S. SERIAL NO. 09/739,706
PATENT

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 11/24/2003



Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@davismunck.com